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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,806	07/02/2003	Allon G. Englman	47079-00208	5370

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EXAMINER	
HSU, RYAN	

ART UNIT	PAPER NUMBER
3714	

MAIL DATE	DELIVERY MODE
12/31/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/612,806	ENGLMAN ET AL.	
	Examiner	Art Unit	
	Ryan Hsu	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 December 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *35-69* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *35-69* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *3/27/08*
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

In response to the amendments filed on 5/24/04, claims 1-34 have been canceled without prejudice and claims 35-69 have been newly amended. Claims 35-69 are pending in the current application. It is noted that this is a response with respect to the preliminary amendments and the previous action dated 1/10/07 is hereby retracted as the claims addressed are no longer relevant to the application.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 35-43, 54-58, are drawn to a method for awarding a progressive pool to a player, classified in class 463, subclass 28.

II. Claims 44-53, 59-66, and 69, are drawn to a method for choosing which of a plurality of progressive pools are awarded to a player, classified in class 463, subclass 25.

III. Claims 67-68, drawn to a game machine that is capable of coupling a connection port to a signage that receives player selectable inputs, classified in class 463, subclass 20.

The inventions are distinct, each from the other because of the following reasons:

Group I of the applicant's application is a combination that has utility by itself, since the applicant's claim is directed towards a method of having a progressive game that displays player-selectable game elements and awards a progressive game payoff in response to the player selecting a certain set of player-selectable game elements. Additionally, group I then awards a progressive game payoff in response to the player selecting a certain set of the player-selectable

game elements. This is opposed to the subcombination that is recited in the claims of Group II in the instant application, which does not require the particularities for patentability because:

a) Group II is directed towards a method of determining receiving a response of the player inputs and then determining which of a first progressive or second progressive game payoff is selected and paid to the player.

b) Additionally, the claims of group II are directed subject matter were a first progressive payoff and a second progressive payoff exists and the second progressive payoff is greater than the first progressive payoff.

c) The particularities of the combination, such as generically described by the summary of group I are not required for the different embodiments and species exemplified by the client in the drawn claims of group II. The claims of group I are directed towards a method of a progressive game, whereas, the method of group II is directed towards specific limitations that define a specific type of progressive game play that incorporates a plurality of progressive pools that are determined to be awards based upon a player's selection. The particularities of group I do not necessarily have to be implemented on progressive game as described by group II. The claimed invention of group I could easily be adapted to be performed on various other types of progressive games as well as the progressive pool game described in group II.

Inventions I, II, and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as

claimed because group I and II are directed towards a networked progressive game that determines whether a player can enter a progressive game terminal and activates a progressive game in response to achieving a game entry reward. Additionally the invention of group I is directed towards awarding a progressive game payoff in response to player selecting a certain set of player selectable game elements. Furthermore, group II is directed towards a progressive game method that determines choosing which of a plurality of progressive jackpots that are awarded to a player. Thus the subcombination of group III has separate utility from group I and II as the game machine of group III incorporates the use of a connection port to be coupled to a signage located adjacent game terminal. The specifics of the generic game machine claimed in group III has separate utility as they are capable of being used for any type of progressive game port or any type of signage that is located in the vicinity of the game machine and does not require the specifics required by the game method of group I or group II..

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Conclusion

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan Hsu whose telephone number is (571)272-7148. The examiner can normally be reached on 9 :00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571)272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RH
December 21, 2007

JOHN M. HOTALING, II
PRIMARY EXAMINER